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REMARKS

The Examiner is thanked for the thorough examination of this application and the indication that claim 20 contains allowable subject matter. The Office Action, however, tentatively rejected the remaining claims 7-19.

In this response, claim 14 has been amended by incorporating the limitations of "wherein the AC current flows on the first load reduced as time increased" and "a current transformer having a primary winding and a secondary winding, the primary winding connected with the first load in series, such that the secondary winding generating an induced current according to the AC current". The limitation of "wherein the AC current flows on the first load reduced as time increased" was previously recited in claim 15 (no canceled). Support for the amendment of adding the limitation of the primary winding connected with the first load in series is shown in FIG. 4, wherein the first load 10 is connected with the primary winding 4 in series. Accordingly, the amendment adds no new matter to the application.

Claim 21 has been added, including the limitations recited in original claims 14, 9, 10, and 20 and amended the limitation of "the primary winding is connected with the first load in series". Support for the amendment of adding the limitation of the primary winding connected with the first load in series is shown in FIG. 4, wherein the first load 10 is connected with the primary winding 4 in series. Accordingly, this amendment adds no new matter to the application.

New claims 22-26 have been added, reciting the limitations recited in original claims 15-19, respectively. Claim 27 has been added, and includes the limitations recited in original claims 7, 9, 10, and 20. Claims 28-31 have also been added, and recite the limitations recited in original claims 8, 11, 12 and 13, respectively.

Claim Rejections**35 U.S.C. 102(b)**

As claims 7-13 have been canceled, the rejections of those claims are moot.

Claim 14 stands rejected under 35 U.S.C. 102(b) as allegedly unpatentable over McNamara, Jr (U.S. Patent No. 4,047,076). Applicant respectfully traverses the rejections for at least the following reasons.

Claim 14, as amended, recites an electronic device having an illumination circuit, comprising a first load, an AC driving unit for generating an AC current to drive the first load, the AC current flowing on the first load reduced as time increased, a current transformer having a primary winding and a secondary winding, the primary winding connected with the first load in series such that the secondary winding generating an induced current according to the AC current, a second load having an illumination function, and a transformation device connected with the secondary winding and the second load in parallel for transforming the induced current to the AC driving voltage to drive the second load.

NcNamara does not teach, disclose or suggest the claimed features of: "the primary winding connected with the first load in series such that the secondary winding generating an induced current according to the AC current, a second load having an illumination function, and a transformation device connected with the secondary winding and the second load in parallel for transforming the induced current to the AC driving voltage to drive the second load".

Instead, NcNamara teaches that the element 34 and the load 30 are in parallel (rather than in series). Consequently, there is an obvious difference between the cited reference and the claimed embodiments. Thus, NcNamara doesn't teach the primary winding connected with the

first load in series. In addition, in the claimed embodiment, the current flowing on the first load is the same as the current flowing on the primary winding. The first load will increase the impedance as time increase, so the current flowing on the first load is reduced as time increase. However, in figure 11 of the cited reference, the current flowing on the load 30 doesn't reduce as time increases. Thus, the circuit shown in figure 11 of McNamara is not capable of performing the claimed function.

For at least this reason, claim 14 is patentable over the cited art, and the rejection of claim 14 should be withdrawn. Insofar as claim 14 is allowable, claims 16-20, all dependent from claim 14, are also allowable.

New claims

The new claims 21-26 recite, in part, "the primary winding is connected with the first load in series and coupled to the AC driving transformer". At least this feature is not taught by the cited reference. The new claims 27-31 recite, in part, "the impedance and the low-pass filter are connected with the secondary winding and second load in parallel". At least this limitation is not taught by the cited reference. Accordingly, the newly added claims define over the cited art of record.

As a separate and independent basis for the patentability of claims 8, 13, 16, and 18, Applicant submits that the Office Action has failed to identify a proper suggestion or motivation to combine the selective teachings of the various references. In combining McNamara with Konodo (U.S. publication 20030025659), the Office Action stated only that the combination would have been obvious because electroluminescent light has many advantages over fluorescent

lamps." (Office Action, p. 4) This allegation, however, is insufficient to constitute a proper motivation to combine the cited references.

In this regard, it is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W.L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to realize an electronic device with an illumination circuit, as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir.

1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, *inter alia*, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *Gambro Lundia AB*, 110 F.3d at 1579, 42 USPQ2d at 1383 ("The absence of such a suggestion to combine is dispositive in an obviousness determination.").

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int'l Royalty Corp. v. Wang*, No 98-1553 (Fed. Cir. January 27, 2000). Well-established Federal Circuit case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Evidence of teaching or suggestion is "essential" to avoid hindsight. *In re Fine*, 837 F.2d 1071, 1075 (Fed.Cir.1988). A description of the particular "teaching or suggestion or motivation [to combine]" is an "essential

evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed.Cir.1998). Indeed, in forming an obviousness type rejection, "the [Examiner] must identify specifically ... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them." *In re Rouffet*, 149 F.3d 1350, 1359 (Fed.Cir.1998). The Examiner can satisfy this burden of establishing obviousness in light of combination "only by showing some objective teaching [leading to the combination]." *In re Fritch*, 972 F.2d 1260, 1265 (Fed.Cir.1992).

Simply stated, the Office Action has failed to comply with these legal standards. Consequently, the rejections of the respective claims are legally improper and must be withdrawn.

Cited Art

The cited art made of record, but not relied upon, has been considered but is not believed to impact the patentability of the pending claims.

CONCLUSION

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

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